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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/161,283	09/28/1998	TOMOHIRO MAEKAWA	PMS255979	7428

7590

04/23/2003

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/161,283

Applicant(s)

MAEKAWA, TOMOHIRO

Examiner

Kevin R Kruer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,8-12 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8-12 and 15-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejection of claims 1, 2, 5, and 8-23 are rejected under 35 U.S.C. 112, first paragraph, has been overcome. There is support in the original disclosure for the end point 1.0um in originally filed claim 1.

Double Patenting

2. Claims 1, 2, 5, 8-10, 17, 21, and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,444,298(Tadokoro) in view of US 6,309,739 (Koizumi) for reasons of record.

Claim Rejections - 35 USC § 102

3. Claims 1, 2, 5, 8-12, 15, 17-20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Toritani et al (US 5,169,903).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 5, 8-12, and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO97/30117 (Tadokoro) in view of Koizumi et al (US 6,309,739) or Toritani et al (US 5,169,903) for reasons of record.

5. Claims 1, 2, 5, 8-12, and 15-24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 55-034924A (herein referred to as Toyooka) in view of WO97/30117 (Tadokoro) and Koizumi et al (US 6,309,739) or Toritani et al (US

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5,169,903). Toyooka teaches a decorated methacrylic resin plate comprising a printed polyalkyl methacrylate film and a molded methyl methacrylate polymer layer (abstract). According to an on-site translation, the laminate may comprise a polyalkyl methacrylate printed film on both sides of the methyl methacrylate polymer layer.

Toyooka does not teach that the printed methacrylic resin should comprise the claimed outer layer compositions. However, Tadokoro teaches an acrylic film or sheet made from a resin composition comprising 95-50wt% of an acrylic resin which comprises methyl methacrylate as a main component and 5-50wt% of a multilayer-structured acrylic polymer containing an elastomeric layer (abstract). The resin comprises 50-99wt% methyl methacrylate and 50-1wt% of an alkyl acrylate (col 3, lines 38+). The composition may comprise light stabilizers and UV absorbers (col 4, lines 27+). The sheet may be used as a decorative surface film on a molded product (col 2, lines 37+). For example, the sheet may be printed or colored (col 4, lines 51+). Thus, it would have been obvious to one of ordinary skill in the art to utilize the decorative sheet taught in Tadokoro as the polyalkyl methacrylate printed film of the laminate taught in Toyooka because it maintains surface hardness, and is produced simply and inexpensively.

Tadokoro does not teach the claimed weight average particle size. However, Koizumi teaches a composition comprising 5-50wt% of a crosslinked acrylate elastomer having a two-layered structure, and 50-95wt% of an alkyl methacrylate polymer (abstract). Koizumi teaches that the particle size of the elastomer should have a particle size of at least 0.5-15 μ m, in order to control the film's matting effect, impact

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resistance, transparency, and flex whitening resistance (col 9, lines 17+). Thus, it would have been obvious to one of ordinary skill in the art to utilize elastomers with a particle size of 0.5-15um in the composition taught in Tadokoro in order to control the composition's matting effect, impact resistance, transparency, and flex whitening resistance.

Response to Arguments

Applicant's arguments filed March 4, 2003 have been fully considered but they are not persuasive. Applicant argues that the average particle diameter of the insoluble particles of the composition taught in Toritani is 0.1 to 1um, whereas the claimed invention has particles with an average particle diameter of 1.0-33um. The examiner points out that the particle range taught by Toritani and that claimed by applicant share a common endpoint. The courts have held that "[W]hen, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is anticipated' if one of them is in the prior art." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962)). Thus, the examiner maintains that Toritani anticipates the claimed invention.

The rejection based upon Kizumi is overcome by amendment.

With respect to Tadokoro, Applicant argues that the reference does not teach a laminate wherein two layers containing acrylic rubber particles hold an acrylic resin layer there between. The examiner notes that the rejection never relied upon Tadokoro for the teaching of a three-layered laminate. Rather, the examiner took the position that acrylic rubber particle-containing layer of Tadokoro in view of Koizumi or Toritani read

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on the claimed laminate when the three claimed layers each comprised the same composition because there is no patentable difference between a single-layered film and a laminate comprising multiple layers with identical compositions.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone

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number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

X-RX-


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700